

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: Gregory R. Hintermeister

Serial No.: 10/767,044

Filed: January 29, 2004

For: MULTI-IMAGE FILE APPARATUS AND METHOD

Group Art Unit: 2176

Confirmation No.: 4831

**REPLY BRIEF IN SUPPORT OF APPEAL FROM
THE PRIMARY EXAMINER TO THE BOARD OF APPEALS**

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Appellant hereby submits this reply brief in support of its appeal to the Board of Appeals from the decision dated December 30, 2009, of the Primary Examiner finally rejecting claims 22-32 and 34-43.

I. Rejections under Section 112

In the Answer Brief, the Examiner responds with a new citation to MPEP §2173.05(p), presumably referring to subsection (II). Appellant respectfully submits that the Examiner's new citation does not control for at least two reasons. First, claims 30-32 and 34 are limited to a single statutory class. These claims recite two elements, namely “a computer program that, when executed on a processor, causes the processor to perform a method for rendering images in a computer system” and “(b) computer readable storage media bearing the program.” Both of these elements are ‘apparatus’ elements. The rest of the language in these claims merely consist of various limitations on the claimed “computer program.” Second, even if these claims did contain both apparatus and method elements, the rule in Section 2173.05(p)(II) is limited to direct claims of use. Appellant notes the Director has just recently issued new guidelines that “recognize[] that applicants may have claims directed to [non-transitory] computer readable media.” *C.f.*, *1351 OG 212*. Appellant respectfully submits that a fair inference is that the Director does not consider this type of claim indefinite under MPEP § 2173.05(p)(II).

II. Rejections Under Section 101

In the Answer Brief, the Examiner responds by claiming that “claims 30-32 and 34 recite “computer readable storage media which has been defined by Applicant on page 11 of the Specification as “signal bearing media” which includes carrier waves and signals.” Appellant submits that this contention is factually incorrect. The cited page of its Specification defines two forms of “*storage* media” and one form of “*communications* medium.” Moreover, the “communication medium” category is the only category that could be reasonably interpreted as including carrier waves and signals. As a result, Appellant respectfully submits that its Specification specifically defines “storage media” in a way that excludes carrier waves and signals.

Because claims 30-32 and 34 specifically recite “storage media,” and not ‘signal bearing media’ or ‘communications media,’ Appellant respectfully submits that they are

limited to non-transitory embodiments, and thus, constitute patentable subject matter.
C.f., 1351 OG 212.

III. Rejections under Section 102 and 103:

A. Claims 22-32 and 34-43:

In the Answer Brief, the Examiner concedes that Munro, Miller, and Tucker do not teach or suggest the claimed “multi-image . . . wherein the multi-image file consists of a single data file comprising a primary image and a plurality of secondary images adapted for cooperative display.” Instead, the Examiner relies solely on the unnumbered <ImageGroup id> tag in Wan, Figs. 12 and 13 as teaching this element.

In response, Appellant notes that the Specification in Wan does not contain any specific discussion of the <ImageGroup id> tag. Therefore, it is necessary to rely on the overall context and teaching of the reference to infer its purpose and use. As previously noted, Wan is specifically directed at a method for addressing specific portions of a monolithic audio/visual file. *E.g., Wan, col. 2, lines 16-18 and lines 33-35; col. 6, lines 43-68.* Using this method, a user can download a desired time block (e.g., minutes 15-30), rather than the whole A/V file. *Id. See also Wan, col. 1, lines 35-45* (explaining that the problem overcome is that “a Web user . . . must, in many cases, down-load an inconveniently large and cumbersome amount of information in order to locate useful information”). Given that the whole purpose of Wan is to allow the user to download smaller blocks of data, i.e., fragments of a file, Appellant submits that it is unreasonable to interpret this element as being used to aggregate multiple images into a larger download entity, i.e., a multi-image file. That is, when viewed in context given the overall purpose of Wan, Appellant submits that the user still only downloads a single fragment of a file. The cited <ImageGroup ID> tag merely exists to help the user select the desired fragment.

B. Claims 35-43:

In the Answer Brief, the Examiner responds with new citations to Wan, col. 2, lines 39-67; Wan, col. 17, lines 25-30; and Wan, col. 18, lines 1-20. Taking each new citation in turn:

Wan, col. 2, lines 39-49 and lines 50-67 both are directed to addressing a specific AV fragment on a network juke box. Both sections are silent about actually parsing a received file – multi-image or otherwise - “to identify” “a first subset of images.” Moreover, any parsing that occurs in response to the Xpath-based addressing scheme occurs on the network juke box, and not at the client.

Wan, col. 17, lines 25-30 states that a URI reference can be used to request a specific fragment from the network juke box. Significantly, however, this reference is not used to parse portions of a received file – multi-image or otherwise – “to identify” “a first subset of images” in the received file. Moreover, any parsing of an A/V file that occurs responsive to this URI occurs at the juke box, and not at the client device.

Wan, col. 18, lines 1-20 similarly states that a URI reference can be used to request a specific fragment from the network juke box, and not to parse portions of a received file “to identify” “a first subset of images” in the received file. Moreover, any parsing of an A/V file that occurs responsive to this URI occurs at the juke box, and not at the client device.

As previously noted, claim 35 specifically recites “receiving a multi-image file via a network interface” and then “parsing the multi-image file to identify the one or more images specified by the second codes.” Standard antecedent-basis rules thus require that parsing occur on the ‘receiving’ device, and not on the ‘sending’ device. In Wan, however, any parsing of audio/visual files occurs at the sending device. That is, the browser on the receiver only processes a standard XML document for links to fragments,

as opposed to parsing a received file for “one or more images specified by the second codes” in that file. *Wan, col. 18, lines 4-20.*

IV. Conclusion

For each of the foregoing reasons, Appellant submits that the Examiner's final rejections of claims 22-32 and 34-43 were erroneous, and respectfully requests reversal of these decisions.

Date: August 23, 2010

Respectfully submitted,

By /Grant A. Johnson, Reg. No. 42,696/

Grant A. Johnson

Registration No.: 42,696

From: Grant A. Johnson
IBM Corporation
Intellectual Property Law
Dept. 917, Bldg. 006-1
3605 Highway 52 North
Rochester, MN 55901

Telephone: (507) 253-4660

Fax: (507) 253-2382